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Makoto Soga

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EXAMINER

REGO, DOMINIC E

ART UNIT

PAPER NUMBER

2618

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,663	Applicant(s) SOGA ET AL.	
	Examiner Dominic E. Rego	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/26/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant recites the limitations "second or third identification information" is not found in the Specification.

Claim Objections

3. Claim 3 is objected to because of the following informalities: Claim 3, line 14, Applicant recites the limitations "determining presence or roaming identification information" which should be determining presence of roaming identification information. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2618

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Nasielski et al. (US 2005/0119000).

Regarding claim 4, Nasielski teaches a contents server configured to be connected to a mobile communication network for providing to a mobile unit of a user under a contractual agreement with said mobile communication network a roaming service via another mobile communication network (*Paragraph 0005*), said contents server comprising:

contents transmission means (RADIUS server 150) for receiving a data signal transmitted from a mobile unit (MS 110) via said mobile communication network, and transmitting contents to said mobile unit (MS 110) in response to a request contained in said data signal (*Paragraphs 0057-0062*),

detection means for detecting whether a data signal received by said contents transmission means (RADIUS server 150) is attached with roaming identification information (MSID) added to said data signal, said roaming identification information (MSID) showing that said data signal is transmitted from said mobile unit in another mobile communication network to which said server is not connected and to which said mobile unit does not belong (*Paragraphs 0057-0062*),

Art Unit: 2618

wherein said contents transmission means (RADIUS server), when said detection means detects that said data signal is attached with said roaming identification information (MSID), is configured to transmit to said mobile unit which transmits said data signal a notification that requested contents cannot be transmitted (*Paragraphs 0057-0062*).

Regarding claim 5, Nasielski teaches a contents server configured for connection to a mobile communication network for providing to a mobile unit of a user under contractual agreement with said mobile communication network a roaming service via another mobile communication network (*Paragraph 0005*), said contents server comprising:

contents transmission means (RADIUS server 150) for receiving said data signal transmitted from a mobile unit (MS 110) via said mobile communication network, and transmitting contents to said mobile unit (MS 110) in response to a request contained in said data signal (*Paragraphs 0057-0062*); and

detection means for detecting whether said data signal received by said contents transmission means (RADIUS server 150) is attached with a roaming identification information (MSID) added to said data signal, said roaming identification information showing that said data signal is transmitted from said mobile unit in another mobile communication network to which said server is not connected and to which said mobile unit does not belong (*Paragraphs 0057-0062*),

Art Unit: 2618

wherein said contents transmission means (RADIUS server), when said detection means detects that said data signal is attached with said identification information (MSID), is configured to transmit to said a mobile unit which transmits said data signal, proxy contents for substituting said contents (*Paragraphs 0057-0062*).

Regarding claim 6, Nasielski teaches a contents server wherein:

said detection means configured to detect whether said data signal received by said contents transmission means (RADIUS server 150) is attached with a second identification information for identifying an area served by said mobile communication network to which said mobile unit belongs, or with a third identification information for identifying said mobile communication network itself to which said mobile unit belongs (*Paragraphs 0057-0062*),

wherein said contents transmission means, only when said detection means detects that said data signal is attached with said second or third identification information, configured to transmit contents in accordance with said second or third identification information to said mobile unit (*Paragraphs 0057-0062*).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2618

7. Claims 1,3, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nasielski et al. (US 2005/0119000) in view of Yabe et al. (US 2003/0013458).

Regarding claim 1, Nasielski teaches a communication system comprising:

a mobile communication network for providing to a mobile unit of a user under a contractual agreement with said mobile communication network a roaming service via another mobile communication network (*Paragraph 0005*); and

a contents server for transmitting to said mobile unit contents via said mobile communication network, or via said mobile communication network and said another mobile communication network (*Paragraphs 0057-0062*),

wherein said mobile communication network comprises:

rejection means for determining presence of roaming identification information added to said data signal received from said mobile unit in said another mobile communication network and transmitted to said contents server, and for rejecting a request for any one of contents denoted by said contents identification information stored in said storage means, contained in said data signal which is received by said data relaying means, addresses to said contents server and transmitted from said mobile unit in said another mobile communication network, if the roaming identification information is determined to be present (*Paragraphs 0060-0062, specifically Paragraph 0062: Nasielski*

Art Unit: 2618

teaches it should be noted that these two methods for determining, based on the identification of the home network associated with the MS, whether to grant access to the MS can also be combined in other embodiments. In one possible embodiment, after receiving the DNS Response from the CDG DNS server, the local RADIUS server may attempt one method, and then the other. For example, the local RADIUS server may first determine whether the home network is included among the networks with which the local network has roaming agreements. If there is a roaming agreement with the home network, then access is authorized. If there is no roaming agreement with the home network, then the local RADIUS server contacts the RADIUS server of the home network to determine whether access should be authorized. If the home RADIUS server approves authorization, the local RADIUS server sends an authorization response to the PDSN. If the home RADIUS server does not approve authorization, the local RADIUS server sends a response to the PDSN denying access), except wherein said mobile communication network comprises:

data relaying means for receiving a data signal addressed to said contents server and transmitted from said mobile unit, and transmitting to said contents server the received data signal;

storage means for storing contents identification information identifying contents which are designated not to be transmitted to said mobile unit in said another mobile communication network among contents that can be transmitted from said contents server.

Art Unit: 2618

However, in related art, Yabe teaches wherein said mobile communication network comprises:

data relaying means for receiving a data signal addressed to said contents server and transmitted from said mobile unit, and transmitting to said contents server the received data signal (*Paragraphs 0006 and 0011: Yabe teaches the information retrieval method of (a) acquiring, in a relay center, location information corresponding to a mobile station, the relay center being connected to a first network and a second network including the mobile station, (b) a step of converting, in the relay center, location information acquired in the acquiring step into a character string, (c) a step of proxy retrieval in which the relay center instructs a server connected to the first network to search for information relating to the character string and acquires information from the server*)

storage means for storing contents identification information identifying contents which are designated not to be transmitted to said mobile unit in said another mobile communication network among contents that can be transmitted from said contents server (*Paragraphs 0004, 0007, 0033, 0040, 0055, 0067*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Yabe to Nasielski et al., in order to undesirably distribute location information on the Internet because of highly confidentiality.

Regarding claim 3, Nasielski teaches a relaying unit which is provided in a mobile communication network for providing to a mobile unit of a user under a

Art Unit: 2618

contractual agreement with said network in which said relaying unit is provided, a roaming service via another mobile communication network (*Paragraph 0005*), said relaying unit comprising:

rejection means for determining presence of roaming identification information added to said data signal received from said mobile unit in said another mobile communication network and transmitted to said contents server, and for rejecting a request for any one of contents denoted by said contents identification information stored in said storage means, contained in said data signal which is received by said data relaying means, addressed to said contents server and transmitted from said mobile unit in said another mobile communication network, if roaming identification is determined to be present (*Paragraphs 0060-0062, specifically Paragraph 0062: Nasielski teaches it should be noted that these two methods for determining, based on the identification of the home network associated with the MS, whether to grant access to the MS can also be combined in other embodiments. In one possible embodiment, after receiving the DNS Response from the CDG DNS server, the local RADIUS server may attempt one method, and then the other. For example, the local RADIUS server may first determine whether the home network is included among the networks with which the local network has roaming agreements. If there is a roaming agreement with the home network, then access is authorized. If there is no roaming agreement with the home network, then the local RADIUS server contacts the RADIUS server of the home network to determine whether access should be authorized. If the home RADIUS server approves*

Art Unit: 2618

authorization, the local RADIUS server sends an authorization response to the PDSN. If the home RADIUS server does not approve authorization, the local RADIUS server sends a response to the PDSN denying access), except data relaying means for receiving a data signal transmitted from said mobile unit and addressed to a contents server which provides a contents transmission service, and transmitting to said contents server the received data signal;

storage means for storing contents identification information identifying contents which are designated not to be transmitted to said mobile unit in said another mobile communication network and can be transmitted from said contents server.

However, in related art, Yabe teaches data relaying means for receiving a data signal transmitted from said mobile unit and addressed to a contents server which provides a contents transmission service, and transmitting to said contents server the received data signal (*Paragraphs 0006 and 0011: Yabe teaches the information retrieval method of (a) acquiring, in a relay center, location information corresponding to a mobile station, the relay center being connected to a first network and a second network including the mobile station, (b) a step of converting, in the relay center, location information acquired in the acquiring step into a character string, (c) a step of proxy retrieval in which the relay center instructs a server connected to the first network to search for information relating to the character string and acquires information from the server*);

storage means for storing contents identification information identifying contents which are designated not to be transmitted to said mobile unit in said

Art Unit: 2618

another mobile communication network and can be transmitted from said contents server (Paragraphs 0004, 0007, 0033, 0040, 0055, 0067).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Yabe to Nasielski et al., in order to undesirably distribute location information on the Internet because of highly confidentiality.

Regarding claim 7, Nasielski teaches communication system comprising:

a mobile communication network contractually configured to provide a roaming service to a mobile unit via another mobile communication network (*Paragraph 0005*);

a contents server (RADIUS server 150) configured to transmit content to said mobile unit via said mobile communication network and said another mobile communication network (Paragraphs 0057-0062),

an access rejection function configured to:

determine the presence of roaming identification information within said data signal transmitted to said contents server (RADIUS server 150) from said mobile unit (MS 110) in said another mobile communication network, and reject a request directed to content not transmittable as designated by identification information stored in said memory, wherein said request is addressed to said contents server and transmitted from said mobile unit in said another mobile communication network as indicated by said roaming identification information within said data signal (*Paragraphs 0060-0062, specifically Paragraph 0062*:

Art Unit: 2618

Nasielski teaches it should be noted that these two methods for determining, based on the identification of the home network associated with the MS, whether to grant access to the MS can also be combined in other embodiments. In one possible embodiment, after receiving the DNS Response from the CDG DNS server, the local RADIUS server may attempt one method, and then the other. For example, the local RADIUS server may first determine whether the home network is included among the networks with which the local network has roaming agreements. If there is a roaming agreement with the home network, then access is authorized. If there is no roaming agreement with the home network, then the local RADIUS server contacts the RADIUS server of the home network to determine whether access should be authorized. If the home RADIUS server approves authorization, the local RADIUS server sends an authorization response to the PDSN. If the home RADIUS server does not approve authorization, the local RADIUS server sends a response to the PDSN denying access), except wherein said mobile communication network comprises:

a data relay configured to receive a data signal transmitted from said mobile unit and addressed to said contents server, and configured to transmit said data signal to said contents server;

a memory configured to store identification information, wherein the identification information designates content transmittable from the content server, and content not transmittable to said mobile unit in said another mobile communication network.

However, in related art, Yabe teaches a data relay configured to receive a data signal transmitted from said mobile unit and addressed to said contents server, and configured to transmit said data signal to said contents server (*Paragraphs 0006 and 0011: Yabe teaches the information retrieval method of (a) acquiring, in a relay center, location information corresponding to a mobile station, the relay center being connected to a first network and a second network including the mobile station, (b) a step of converting, in the relay center, location information acquired in the acquiring step into a character string, (c) a step of proxy retrieval in which the relay center instructs a server connected to the first network to search for information relating to the character string and acquires information from the server*);

a memory configured to store identification information, wherein the identification information designates content transmittable from the content server, and content not transmittable to said mobile unit in said another mobile communication network (*Paragraphs 0004, 0007, 0033, 0040, 0055, 0067*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Yabe to Nasielski et al., in order to undesirably distribute location information on the Internet because of highly confidentiality.

Response to Arguments

8. Applicant's arguments with respect to claims 1, and 3-7 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2618

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic E. Rego whose telephone number is 571-272-8132. The examiner can normally be reached on Monday-Friday, 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dominic E. Rego


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